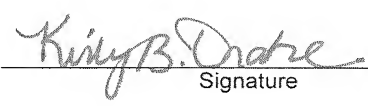
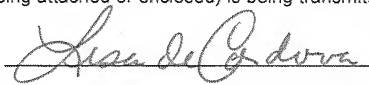


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 65003/P002US/10312242	
	Application Number 10/691,459-Conf. #7339	Filed October 22, 2003	
	First Named Inventor Ajay R. Bam et al.		
	Art Unit 3688	Examiner K. H. Le	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 55,126</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p> Signature Kirby B. Drake Typed or printed name (214) 855-8294 Telephone number August 31, 2009 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of 1 forms are submitted.</p>			

Pre-Appeal Brief Request for Review	
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).	
Dated: August 31, 2009	Signature:  (Lisa deCordova)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:  
Ajay R. Bam et al.

Application No.: 10/691,459

Confirmation No.: 7339

Filed: October 22, 2003

Art Unit: 3688

For: **SYSTEM AND METHOD OF GENERATING,  
DISTRIBUTING, AND/OR REDEEMING  
PROMOTIONAL OFFERS USING  
ELECTRONIC DEVICES**

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Examiner: K. H. Le

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**INTRODUCTORY COMMENTS**

In response to the Office Action dated May 29, 2009, finally rejecting claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63 and 65-73 ("Office Action"), Applicant requests review of the rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below.

**REMARKS**

**I. General**

Claims 66-69 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63, 65 and 66-73 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,237,145 to *Narasimhan* (hereinafter *Narasimhan*) in view of Official Notice and/or legal precedent.

## II. 35 U.S.C. § 101 Rejection

Claims 66-69 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The Office Action alleged that the claims are directed to non-statutory subject matter as they deal with “ a system for redeeming promotions comprising a server and means for conducting the method steps” and a server and the means can be software. Office Action at 2. Applicant maintains that it unclear why the Examiner contends that the recited server and/or means are software per se. However, in an attempt to advance prosecution, Applicant proposed amendments to claims 66, 68 and 69 to recite that the means steps are performed in software stored on a tangible computer readable storage medium. The Examiner refused to enter the amendments, alleging that the specification does not show clear support for the claims as amended and concluding that further consideration is needed. Applicant maintains that these amendments are properly supported by the specification (*see, e.g.*, paragraphs [0008], [0015]-[0016], [0020], [0022], [0028], [0031] of Applicant’s specification) and were prompted by the Examiner’s continued rejection of these claims under 35 U.S.C. § 101. Further, the Examiner even acknowledged that the claims could read on both software per se and software on a tangible computer readable storage medium. Office Action at 3. As such, the Examiner admitted that the amendments made by Applicant are proper to narrow the claim to read on an alleged statutory embodiment. Applicant requests that this rejection be withdrawn.

## III. 35 U.S.C. § 103 Rejection

Claims 1-5, 7-14, 16-22, 26-41, 44-50, 52-63, 65 and 66-73 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Narasimhan* in view of Official Notice and/or legal precedent. Applicant traverses this rejection. The Office Action alleges that the smart card is performing the functions of the claimed “mobile electronic device.” Office Action at 12-13. Applicant maintains that the smart card of *Narasimhan* is not a mobile electronic device as it is not capable of wirelessly transmitting or receiving data through a network. The Office Action has not refuted Applicant’s assertion. A user of the smart card disclosed in *Narasimhan* clips a coupon while sitting at his/her personal computer and stores the coupon in a database on the smart card by employing a smart card reader/writer. *See, e.g.*, column 3, lines 9-16; column 6, lines 30-36; column 7, lines 23-27. Accordingly, the user’s *personal computer* receives data from the server, not the smart card. Accordingly, the user uses his/her personal computer to request data regarding a promotion from a remote server and

does not use the smart card to make such a request. The coupons generated on a user's computer are transmitted for storage on the smart card only when the smart card is *physically* associated with the smart card reader/writer and *not* through any wireless mechanism.

The user redeems a coupon stored on the smart card by swiping or inserting the smart card through a smart card reader/writer attached to the merchant device. *See, e.g.*, column 6, lines 52-57; column 7, lines 27-31. The smart card of *Narasimhan* does not include any mechanism (i.e., input means) to allow a smart card user to wirelessly reply to a server using the smart card. The smart card is tethered to the reader/writer in order for promotions to be read from or stored onto the smart card. The merchant does not read the clipped electronic coupons from a mobile electronic device in *Narasimhan* but rather reads the coupons stored on the database by use of a smart card reader/writer. Accordingly, the smart card of *Narasimhan* neither wirelessly transmits a request for promotional data nor does it wirelessly receive generated promotional data.

Applicant contends that Examiner Myhre did not take Official Notice during the prosecution of the present application. Applicant does not find statements such as "it is known before invention time" in Examiner Myhre's rejections, and Examiner Myhre did not rely upon any references other than *Narasimhan* in making his rejections, contrary to the present Examiner's allegations. *See, e.g.*, Advisory Action mailed August 11, 2009. The present Examiner fails to identify any Official Notice taken by Examiner Myhre in the Office Actions mailed December 7, 2007 and April 22, 2008, the Examiner Interview or the Advisory Action mailed July 2, 2008. Prosecution of the present application was turned over to the present Examiner upon filing of the Request for Continued Examination on July 22, 2008. *See id.* Applicant therefore is not aware of any Official Noticed facts taken earlier by Examiner Myhre and is not aware of a procedure by which the present examiner can rely on statements made by a previous examiner in a prior office action as official notice in the absence of any documentary evidence. As such, Applicant respectfully requests that any rejections made with respect to Examiner Myhre's alleged Official Notice be withdrawn.

While the smart card may be carried around by the user, there is no teaching set forth in the reference for incorporating the *Narasimhan* smart card into other mobile devices or updating the smart card with "modern components." Further, the references cited in the Office Action do not demonstrate the interchangeability of the *Narasimhan* smart card with

other user devices. Applicant asserts that it would not have been obvious to replace the “unit including the card interface of *Narasimhan* with a cell phone with chip card communications port as taught by *Freeman* or with a portable phone as taught in *Aggarwal*” as the Office Action suggests. Office Action at 11-12. These references cited to support the alleged Official Notice fail to teach the limitations not taught by *Narasimhan*. *Freeman* merely references downloading onto a chip card through a cellular device having a chip card communications port. *See, e.g.*, column 8, lines 24-31. The chip card is then inserted into the POS terminal to establish communication. *See, e.g.*, column 16, lines 9-12; column 17, lines 5-7. Thus, communication to apply a promotion is by electrical connection of the chip card to the POS terminal. No description is provided to allege that communication is made through wireless means. In addition, the Office Action’s reliance on *Aggarwal* fails to demonstrate that various user devices or terminals may be used interchangeably with the smart card of *Narasimhan*. The portion of *Aggarwal* cited in the Office Action describes *later* downloading coupons in a portable device but does not equate a smart card of the type set forth in *Narasimhan* as being interchangeable with other wireless devices as set forth in Applicant’s claims. The Office Action asserts that *Aggarwal* allegedly shows “the interchangeability of the several mobile devices to transfer promotion-related data, including using cellphones which clearly are wireless devices.” *See* Office Action at 29. Applicant respectfully maintains that it would not have been obvious to substitute different cell phone devices as disclosed in *Aggarwal* with the smart card of the type set forth in *Narasimhan*, and the Office Action has not provided support to the contrary. Regardless whether *Aggarwal* teaches the use of cellular phones, the Examiner has not demonstrated how the cellular phone allegedly disclosed in *Aggarwal* may be properly incorporated into the system allegedly taught by *Narasimhan*. *Kolls* discusses use of a smart card reader/writer but does not address how such a reader/writer may be interchanged with wireless devices and networks as the Office Action suggests. Rather, Figure 4 of *Kolls* is described as having mutually exclusive control means. *See, e.g.*, column 9, lines 37-38. The Office Action has not demonstrated that the references evidence the level of skill in the art at the time of the invention so as to support the assertion that the allegedly Official Noticed facts discharge the burden of showing *prima facie* obviousness. Applicant maintains that *Leapfrog v. Fisher-Price* is not applicable.

Dependent claims 2-5, 7-12, 14, 16-21, 27-29, 31-36, 38-40, 44-48, 50, 52-54, 56-60, 62-63, 65, 67-69, and 71-73 depend directly or indirectly from their respective independent

claims and thus inherit all limitations of their respective independent claim. However, each of these claims set forth features and limitations not recited by the references. For example, claims 3, 16, 68-69, 72 and 73 are generally directed toward receiving a response from the mobile electronic device in a wireless manner and wirelessly requesting or receiving information using a mobile electronic device. *Narasimhan* does not teach these limitations as any communication that the smart card user has occurs via action by the merchant device or the user's personal computer, not the smart card. *See, e.g.*, column 6, lines 30-36 and 52-57; column 7, lines 27-37. Similarly, claims 7, 8, 21, 33, 35, and 58 are not taught by *Narasimhan* as text messages or voice mail messages are not transmitted from a smart card. Data is not pulled from the smart card of *Narasimhan* other than by swiping or inserting the smart card through a card reader, and the electronic coupon itself is read from the smart card. Rather, the user generally communicates using his/her personal computer. When the promotion is received, it is only then saved onto the smart card, and there are no input means on the smart card. *See, e.g.*, column 6, lines 30-36; column 7, lines 23-27. Further, *Narasimhan* discloses Internet or telephone interfaces to describe how the server may be connected to the user's personal computer, *not* the form that the smart card may assume.

#### IV. Summary

In view of the above, Applicant respectfully requests that the review panel reverse the outstanding rejections in the present application. The required fee for the Notice of Appeal filed with this request is being paid by credit card. Please charge any additional fees required or credit any overpayment during the pendency of this Application pursuant to 37 CFR §§ 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees to Deposit Account No. 06-2380, under Order No. 65003/P002US/10312242 from which the undersigned is authorized to draw.

Dated: August 31, 2009

Respectfully submitted,

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: August 31, 2009

Signature: *Lisa de Cordova*  
(Lisa deCordova)

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